

REMARKS

In this application, the following issues are outstanding:

The drawings are objected to. Claim 5 is objected to. Claims 1-10 are rejected under 35 U.S.C. § 103. Applicants traverse the outstanding rejections based on the remarks and amendments presented herein. Claims 1-2, 4, 7, and 9 are original, claims 3, 6, 8, and 10 are currently amended, and claim 5 is canceled. Claims 1-4 and 6-10 are pending in this application. No new matter has been added.

Objections to the Drawings:

Figures 12A and 12B are objected to “because figure 12A and 12B both are cut off slightly at the bottom of the page.” See Office Action, page 2. Separately, the Office Action Summary sheet (PTOL-326) indicates that the drawings filed on “09 January 2002” are objected to by the Examiner.

Applicants note that the application as filed included only Figures 1-3 and was filed on June 19, 2001. Applicants have reviewed the file history in Applicants’ possession and the file history as recorded in PAIR and can find no record of any filing by Applicants in this application, of drawings or any other document, on January 9, 2002. Thus, this application does not include any drawings labeled “Figure 12A” or “Figure 12B.” Thus, Applicants believe that the objection to the drawings is in error. Accordingly, no substitute drawings have been provided. On July 6, 2005, the Examiner indicated, in a conversation with Applicants’ counsel, that the foregoing remarks would be considered responsive to the outstanding objection to the drawings and that these remarks would be considered upon receipt of this response by the

Examiner. Applicants would be happy to discuss this matter with the Examiner by telephone to identify any outstanding issues regarding the drawings in this application.

Changes to the Claims:

Claim 3 has been amended to more clearly recite the subject matter sought to be patented and to ensure that proper antecedent basis is present throughout the claim. Specifically, the term “user of the portable electronic device”, introduced in the preamble, has been substituted for the term “recipient” formerly recited in the body of the claim. Support for this change may be found throughout Applicants’ specification, and particularly on page 3, lines 16-20, page 5, lines 10-12, and page 6, line 20 to page 7, line 7. Applicants contend that claim 3 has not been narrowed by this amendment and that no new matter has been added thereby.

Claim 6 has been amended to provide more consistent use of the terminology therein and to ensure that all terms used have proper antecedent basis. Support for the changes to claim 6 may be found on pages 5-6 of Applicants’ specification, as filed. In particular, support for the amendment to paragraph (c) of claim 6 is supported on page 5, lines 15-17 and on page 6, lines 7-9. Also, for the sake of clarity, the singular term “indicium” has been used in place of the plural term “indicia” which is recited on page 5, line 16. The amendments to claim 10 parallel those made to claim 6, and the passages of the specification cited above in support of the changes to claim 6 also support the changes to claim 10.

Claim 8 has been amended to replace the word “caller” with the term “user of the portable electronic device” to be consistent with claim 6. Support for this change may be found on pages 5-7 of Applicants’ specification and particularly on page 6, lines 20-21. No new matter

has been added.

Objections to the Claims:

In response to the Examiner's objection, claim 5 has been canceled without prejudice.

Rejection under 35 U.S.C. 103(a):

Claims 1-2 are rejected as being unpatentable over Woltz et al. (U.S. Patent No. 5,995,597, hereafter Woltz) in view of Ron et al. (U.S. Patent No. 6,775,359, hereafter Ron) under 35 U.S.C. § 103(a). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criterion, Applicants contend that the first and third criteria are not satisfied.

There is Insufficient Motivation to Combine Ron with Woltz.

The Office Action asserts that it would have been obvious to combine the system of Woltz with the method of Ron "because both are providing ways of improving the retrieval and response to e-mail when away from the home or office workstation." The foregoing merely alleges that the various references are directed to related fields of endeavor. The Office Action's own statement does not indicate why it would be *desirable* to combine Woltz with Ron. Moreover, even assuming that these two references can be combined, the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01; *In Re Mills*, 916 f.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1430). In this case, the references are silent as to the desirability of combining the system of Woltz with the method of Ron.

Moreover, the references and the Office Action are also silent with regard to *how* such a combination would be achieved. Notably, the Office Action proposes combining the *system* of

Woltz with the *method* of Ron. However, neither the Office Action nor the references identify how such incompatible systems would be “combined.” Woltz is directed to a system for promptly notifying a recipient of the transmission of an email message by sending a signal to the email recipient’s pager. See Woltz, Abstract. Woltz does not disclose any equipment capable of either transmitting or receiving voice data, which steps are central to the method of Ron. Thus, practicing the “method of Ron” would be impossible using the “system of Woltz” as this system is currently disclosed in the Woltz specification. Moreover, neither the Office Action nor the prior art disclose how to modify Woltz to enable it to use the method of Ron. Thus, Applicants contend that the proposed combination of references provides an inoperative system, which teaches away from the proposed combination of references.

The Prior Art does not Teach or Suggest All the Limitations of Claim 1.

Claim 1 recites the limitation “if the intended recipient is authorized, appending a reply notice with the message-specific indicia to the message”. The Office Action contends that Ron (col 6, lines 24-34) teaches this limitation. Applicants disagree for the following reasons.

Attention is directed first to the language “if the intended recipient is authorized.” This language imposes a condition on the subsequently listed step of “appending,” this condition being that the intended recipient be “authorized.” Ron does not disclose imposing this condition. In the cited portion of Ron, the recipient has already received the email message. The pertinent condition in Ron is that the recipient wishes to postpone replying to an incoming message. Ron recites “[i]f the recipient wishes to reply to an incoming message later (i.e. not in the current session . . .)”. Col. 6, lines 24-25 (emphasis added). Ron’s condition of replying “later” is different from and unrelated to claim 1’s condition of the recipient being “authorized.” Moreover, in the pertinent passage of Ron, the recipient’s “authorization” is a moot point, since the passage (col. 6, lines 24-34) discusses the actions the recipient may take *after* receiving the email message. Further, the “recipient” in the pertinent passage of Ron is an actual recipient, not an “intended” recipient, since the message has already been received. Accordingly, Ron does not teach or suggest the limitation “if the intended recipient is authorized.”

The later portion of the above-quoted limitation recites “appending a reply notice with the message-specific indicia to the message”. Ron does not teach or suggest this limitation. Instead, Ron discloses that, if the recipient wishes to reply to the message later, “the system provides the recipient a parameter associated with a specific incoming message.” Col. 6, lines 27-29 (emphasis added). Mere “association” of a parameter with an already received email message does not correspond to appending information to this message. Moreover, there would no benefit or motivation to appending information to the email message in Ron’s discussion at col. 6, lines 24-34, to meet the limitations of Applicants’ claim 1, since at that point, the email message has already been sent and received. Thus, Ron does not teach or suggest the above-quoted “appending” limitation of claim 1. The proposed combination of references therefore does not teach or suggest all the limitations of claim 1.

Accordingly, Applicants contend that the proffered combination of references does not satisfy the first and third criteria of the prima facie case of obviousness under M.P.E.P. § 2143, and that claim 1 is therefore patentable over Woltz in view of Ron under 35 U.S.C. § 103(a). Claim 2 depends from claim 1, includes all the limitations thereof, and is therefore patentable over Woltz in view of Ron for the same reasons as claim 1. Moreover, claim 2 defines further novel, nonobvious limitations not taught or suggested in the prior art. Claims 1-2 are therefore patentable over Woltz in view of Ron under 35 U.S.C. § 103(a).

Rejection under 35 U.S.C. § 103(a):

Claim 3 is rejected as being unpatentable over Woltz in view of Ron further in view of Okada et al. (U.S. Patent 6,463,134, hereafter Okada). Without conceding the second criterion of the prima facie case of obviousness under M.P.E.P. § 2143, Applicants submit that the proffered combination of prior art does not teach or suggest all the limitations of claim 3, and that there is insufficient motivation to combine the references.

The Prior Art Does not Teach or Suggest All the Limitations of Claim 3.

Claim 3, as amended, defines the limitation “appending a reply notice comprising an instruction to the user of the portable electronic device that in order to reply to the text email by

phone the user of the portable electronic device must initiate a telephone call to a selected phone number and enter the assigned message-specific indicia". (Emphasis added). The Office Action contends that Okada teaches the "appending" limitation of claim 3. Applicants disagree for the following reasons.

Okada is directed to an "Easy Response System" that enables the user of a portable device to respond to an emailed query by using key input to provide a "yes" or "no" reply. However, Okada is silent with respect to the user entering message-specific indicia. With regard to user input, Okada discloses that "the key input section 34 passes input key information received from the keypad 35 to the operation description section 36." See col. 13, lines 18-20. Okada later discloses that the operation description section "converts the key input information into operation description of reply mail preparation of yes or no, a voice response system or the like." Col. 13, lines 23-26. Thus, even if key input information corresponds to "user inputted" information, Okada discloses no more than that this information may include a representation of a "yes" or "no" reply (to an incoming message) or voice data. Such information does not correspond to claim 3's instruction to enter "assigned message-specific indicia."

Separately, Okada discloses the use of "mail ID" as a key for electronic mail management. See col. 12, lines 66-67. However, Okada does not disclose that the *user* of the portable telephone of Okada ever enters this information, as claimed in claim 3. In the very section cited by the Examiner in rejecting claim 3 (col. 13, lines 25-35), Okada discloses that "the voice mail server communication section . . . gets the mail ID from the gateway communication section 31, and originates a call with the mail ID attached to the voice mail server 40." See col. 13, lines 25-35 (emphasis added) and FIG. 3. However, the only functional block of FIG. 3 that can plausibly receive input from a user is the "key input section" 34. Thus, the receipt of the mail ID from gateway communication section 31 precludes the possibility that the *user* of portable telephone 30 provides the mail ID information. Accordingly, the disclosure of Okada, including the portion cited by the Examiner, does not teach or suggest the above-quoted limitation of claim 3. Moreover, neither Woltz nor Ron teach or suggest this limitation. Thus, the proffered combination of prior art does not teach or suggest all the limitations of claim 3. Accordingly, the third criterion for the prima

facie case of obviousness of claim 3 under M.P.E.P. § 2143 is not satisfied.

There is Insufficient Motivation to Combine the References.

The Office Action asserts that it would have been obvious to combine the system of Woltz with the method of Ron and the method of Okada “because they are providing ways of improving the retrieval and response to e-mail when away from the home or office workstation.” The foregoing merely alleges that the various references are directed to related fields of endeavor. The Office Action’s own statement does not identify why it would be *desirable* to combine Woltz with Ron and Okada. Moreover, assuming that these three references *can* be combined, the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01; *In Re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1430). In this case, the references are silent as to the desirability of modifying the system of Woltz to use the methods of Ron and Okada.

Moreover, the references and the Office Action are also silent with regard to *how* such a combination would be achieved. Notably, the Office Action proposes combining the *system* of Woltz with the *methods* of Ron and Okada. However, neither the Office Action nor the references identify how such incompatible systems would be “combined.” Woltz is directed to a system for promptly notifying a recipient of the transmission of an email message by sending a signal to the email recipient’s pager. See Woltz, Abstract. However, Woltz does not disclose any equipment capable of either transmitting or of receiving voice data, which steps are disclosed as being part of the methods of Ron and Okada. Thus, practicing the “methods of Ron and Okada” would be impossible using the “system of Woltz” as the system is currently disclosed in the Woltz specification. Yet, neither the Office Action nor the prior art disclose how to modify Woltz to enable it to use the method of Ron. Thus, Applicants contend that the proposed combination of references would provide an inoperative system, which teaches away from the proposed combination.

In view of the foregoing, Applicants contend that there is insufficient motivation to combine Woltz with Ron and Okada and that the first and third criteria of the prima facie case of obviousness

under M.P.E.P. § 2143 are not satisfied. Claim 3 is therefore patentable over Woltz in view of Ron further in view of Okada under 35 U.S.C. § 103(a).

Rejection under 35 U.S.C. § 103(a):

Claim 4 is rejected under 35 U.S.C. § 103(a) over Woltz in view of Ron further in view of Okada and Cooper et al. (U.S. Patent No. 6,757,362, hereafter Cooper). Applicants have already shown that claim 3 is patentable over Woltz in view of Ron further in view of Okada. Moreover, Cooper does not cure the deficiencies of the other references with respect to claim 3. Accordingly, claim 3 is patentable over the combination of Woltz, Ron, Okada, and Cooper. Claim 4 depends from claim 3, inherits all the limitations thereof, and is therefore patentable over the prior art for the same reasons as claim 3. Moreover, claim 4 recites further novel, nonobvious limitations not taught or suggested by the prior art. Thus, claim 4 is patentable over Woltz in view of Ron further in view of Okada and Cooper under 35 U.S.C. § 103(a). Claim 5 has been canceled without prejudice, and the rejection thereof is therefore considered moot.

Rejection under 35 U.S.C. § 103(a):

Claims 6, 7, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ron in view of Okada. Without conceding the first and second criteria of the prima facie case of obviousness, Applicants submit that the proffered combination of prior art does not teach or suggest all the limitations of the rejected claims.

Claim 6, as amended, recites “obtaining a pre-assigned message-identifying indicium from the user of the portable electronic device, the message-identifying indicium having been assigned to an email message received by the user of the portable electronic device prior to a transmission of the email message thereto.” (Emphasis added). The prior art does not teach or suggest this limitation. The Office Action asserts that Ron teaches the “obtaining” step. However, in the portion of Ron cited by the Office Action for this alleged teaching (col. 6, lines 24-34), a parameter is associated with an email message only after the email message has been transmitted to, and received by, the user of the portable device. Col. 6, lines 24-34. Thus, Ron does not teach the above-quoted limitation of claim 6. Accordingly, the third criterion of the prima facie case of obviousness is not

satisfied. Claim 6 is therefore patentable over Ron in view of Okada under 35 U.S.C. § 103(a).

Claims 7 and 9 depend from claim 6, inherit all the limitations thereof, and are therefore patentable over Ron in view of Okada for the same reasons as claim 6. Moreover, claims 7 and 9 recite further novel, nonobvious limitations not taught or suggested by the prior art. Accordingly, claims 6, 7, and 9 are patentable over Ron in view of Okada under 35 U.S.C. § 103(a).

Rejection under 35 U.S.C. §103(a):

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ron in view of Okada further in view of Cooper. Applicants have already shown that claim 6 recites limitations not taught or suggested by Ron and Okada. Moreover, Cooper also does not teach or suggest these missing limitations. Accordingly, claim 6 is patentable over Ron in view of Okada further in view of Cooper. Claim 8 depends from claim 6, inherits all the limitations thereof, and is therefore patentable over Ron, Okada, and Cooper for the same reasons as claim 6. Moreover, claim 8 recites further novel, nonobvious limitations not taught or suggested by the prior art. Accordingly, claim 8 is patentable over Ron, Okada, and Cooper under 35 U.S.C. § 103(a).

Rejection under 35 U.S.C. § 103(a):

Applicants note that the Office Action does not include an initial formal statement summarizing the basis for rejection of claim 10. However, it appears that claim 10 is rejected under 35 U.S.C. § 103(a) over McAllister (U.S. Patent No. 6,442,242, hereafter McAllister) in view of Ron, further in view of Woltz. Accordingly, Applicants have responded below assuming that the foregoing is the basis for the rejection of claim 10. Without conceding the second criterion of the prima facie case of obviousness, Applicants contend that the proffered combination of prior art does not teach or suggest all the limitations of claim 10 and that there is insufficient motivation to combine the references.

There is Insufficient Motivation to combine Ron with Woltz.

Applicants have entered remarks asserting that there is insufficient motivation to combine Ron with Woltz. To avoid needless repetition, those remarks (in response to the rejection of claim 1

above) are incorporated into this section.

The Proposed Combination Does Not Teach or Suggest All the Limitations of Claim 10.

Claim 10 recites “obtaining a pre-assigned message-identifying indicium from the user of the portable electronic device, the message-identifying indicium having been assigned to an email message received by the user of the portable electronic device prior to a transmission of the email message to the user.” None of the cited references teach or suggest this limitation. The Office Action contends that Ron teaches the quoted limitation, pointing to col. 6, lines 24-34 thereof. In this passage of Ron, a recipient of a message can receive a parameter associated with a specific incoming email message to which he wishes to reply. Since this parameter is first provided to a recipient in connection with an already received email message, this parameter could not have been assigned to the email message “prior to a transmission of the email message” to the user as claimed in claim 10. Accordingly, Ron does not teach or suggest the above-quoted limitation of claim 10.

The Office Action also contends that Woltz teaches the above-quoted limitation of claim 10, citing col. 5, lines 25-41 thereof. The cited passage of Woltz discloses that “block 101 determines whether the message is a reply from a two-way pager. The “two” fields in the header for a reply message will contain a logged message number and identify the host computer.” Col. 5, lines 28-31. However, Woltz does not teach or suggest that the logged message number is obtained from the user of the portable electronic device. Accordingly, Woltz does not teach or suggest the above-quoted limitation of claim 10. Applicants note that the Office Action acknowledges that McAllister “fails to teach” this limitation.

Therefore, the proffered combination of prior art does not teach or suggest all the limitations of claim 10. Thus, the first and third criteria of the prima facie case of obviousness of claim 10 are therefore not satisfied. Accordingly, claim 10 is patentable over McAllister in view of Ron further in view of Woltz under 35 U.S.C. § 103(a).

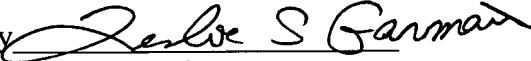
In view of the foregoing, claims 1-4 and 6-10 are allowable.

Conclusion:

Based on the foregoing, Applicants assert that all pending claims are allowable and respectfully request that the instant application be passed to issue. The Examiner is authorized to deduct any fees believed due or to credit any overpayment from/to our deposit account No. 11-0223. We respectfully request the Examiner telephone the undersigned if there are any further issues preventing the case from being passed to allowance.

Dated: July 11, 2005

Respectfully submitted,

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